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| 10/091,794      | 03/06/2002  | Margaret Paige Smith | PU020055            | 8937             |

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EXAMINER

CORRIELUS, JEAN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2162

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/091,794

Applicant(s)

SMITH, MARGARET PAIGE

Examiner

Jean M Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03/06/02 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the Application filed on March 6, 2002, in which claims 1-15 are presented for examination.

#### ***Drawings***

2. The drawings are objected to because in FIG.5A- FIG.5D, the boxes are not labeled. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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12. Claims 1-15 are rejected under 35 U.S.C.101 because the language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practice application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

As regarding claim 1:

The preamble of the claim 1 states “a method for automatically ordering replacement of consumable parts of a system”. The claim fails to contain a computer that is used implemented the method for automatically ordering replacement of consumable parts of a system. The recited steps of the method of claim are something that can be done by a person as a mental step or using pencil and paper. Claim is non-statutory, since it is not **tangibly embodied** in a manner so as to be executable as the only hardware is in an intended use statement.

As to claim 8:

The preamble of the claim 8 states “a method for automatically ordering replacement of consumable parts of an appliance”. The claim fails to contain a computer that is used implemented the method for automatically ordering replacement of consumable parts of an appliance. The recited steps of the method of claim are something that can be done by a person as a mental step or using pencil and paper. Claim is non-statutory, since it is not **tangibly embodied** in a manner so as to be executable as the only hardware is in an intended use statement.

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As to claim 9:

The preamble of the claim 8 states “a system for automatically ordering replacement of consumable parts of an appliance”. The claim fails to contain a computer that is used implemented the system automatically ordering replacement of consumable parts of an appliance. The recited steps of the system of claim are something that can be done by a person as a mental step or using pencil and paper. Claim is non-statutory, since it is not **tangibly embodied** in a manner so as to be executable as the only hardware is in an intended use statement.

As to claims 2-7 and 10-15

The dependent claims 2-7 and 10-15 are rejected for fully incorporating the errors of their respective base claims by dependency. Thus, claim 2-3, 5 and 7-9 are merely abstract idea and are being processed without any links to a practical result in the technology arts and without computer manipulation. They are not **tangibly embodied** in a manner so as to be executable as the only hardware is in an intended use statement.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cornett et al., (hereinafter Cornett) US Patent No. 5,216,612 and Crisp, III (hereinafter “Crisp”) US Patent No. 6,799,085.

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As to claim 1, Cornett discloses an electronically stored part manual, which contains a hierarchical listing of parts in the plurality of production machines in the plurality of production lines. In particular, Cornett discloses the claimed “monitoring at least one parameter for a part of said system” a computer integrated maintenance system when a machine is reaching the end of its useful life, either because the machine is worn out or because the machine is scheduled to be replaced or modified in an upgrade (col.4, lines 43-46; col.13, lines 25-30; col.15, lines 26-42); “comparing said parameter to at least one replacement criterion said part” (col.5, lines 55-59; col.13, lines 31-40; col.15, lines 26-42); “automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered”; and “responsive least one action selected from the group consisting a user input and an automatic system control, automatically communicating an order to a replacement part order center a replacement for said part” (col.13, lines 25-50; col.15, lines 26-42. However, Cornett does not explicitly disclose the use of “automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered”; and “responsive least one action selected from the group consisting a user input and an automatic system control, automatically communicating an order to a replacement part order center a replacement for said part”.

Crisp discloses an analogous system that provides the use of “monitoring at least one parameter for a part of said system” monitoring the amount of each type of appliances supply dispensed (col.17, lines 8-15; col.21, lines 8-18; lines 37-42); “automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered” (col.16, lines 55-62; col.17, lines 17-26; col.19, lines 42-

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47); and “responsive least one action selected from the group consisting a user input and an automatic system control, automatically communicating an order to a replacement part order center a replacement for said part” (col.4, lines , lines 12-13, lines 23-26, lines 45-67; col.7, lines 18-23; col.8, lines 3-14; col.13, lines 58-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the intelligent computer integrated maintenance system, provided therein (see Cornett’s fig.1, item 1) would incorporate the use of automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered, in the same conventional manner as disclosed by Crisp (col.16, lines 55-62; col.17, lines 17-26; col.19, lines 42-47). One having ordinary skill in the art would have found it motivated to generate a user notification indicated when a replacement part should be ordered because that provide Cornett’s system the enhanced capability of making appropriate orders as necessary

As to claim 2, Crisp discloses the claimed “communicating said replacement part order center at least one billing address, a billing account, a shipping address, and a part identification code“ serial number, planning bill (col.14, lines 58-60, col.15, lines 50-60; col.16, lines 1-10).

As to claim 3, Crisp discloses the claimed “transmitting said order to said replacement part order center through least one of a global computer network, cable television network, a wireless link, and a dial-up telephone line” as dial-up connection (col.8, lines 10-14)

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As to claim 4, discloses the claimed “wherein said parameter selected from the group comprising a duration, output level, an input level, an operating temperature, a number of on-off cycles, an oxidation level, a corrosion level, a decomposition level and a material elasticity level” determining when the machine is reaching the end of its useful life (duration or life cycle) (col.4, lines 43-44).

As to claim 5, Crisp discloses the claimed “wherein said parameter for said part an output level for a light source” (col.21, lines 60-67).

As to claim 6, Crisp discloses the claimed “wherein said system projection display and said part light source” ” (col.21, lines 60-67).

As to claim 7, Crisp discloses the claimed “wherein said replacement part order center is a computer server” (col. 14, lines 23-38).

As to claims 9-15:

Claims 9-15 are system of claims for performing the method of claims 1-7. They are, therefore, rejected under the same rationale.

As to claim 8, Cornett discloses an electronically stored part manual, which contains a hierarchical listing of parts in the plurality of production machines in the plurality of production lines. In particular, Cornett discloses the claimed “monitoring at least one parameter for a part of



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said system” a computer integrated maintenance system when a machine is reaching the end of its useful life, either because the machine is worn out or because the machine is scheduled to be replaced or modified in an upgrade (col.4, lines 43-46; col.13, lines 25-30; col.15, lines 26-42); “comparing said parameter to at least one replacement criterion said part” (col.5, lines 55-59; col.13, lines 31-40; col.15, lines 26-42); “automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered”; and “responsive least one action selected from the group consisting a user input and an automatic system control, automatically communicating an order to a replacement part order center a replacement for said part” (col.13, lines 25-50; col.15, lines 26-42. However, Cornett does not explicitly disclose the use of “automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered”; and “responsive least one action selected from the group consisting a user input and an automatic system control, automatically communicating an order to a replacement part order center a replacement for said part”.

Crisp discloses an analogous system that provides the use of “monitoring at least one parameter for a part of said system” monitoring the amount of each type of appliances supply dispensed (col.17, lines 8-15; col.21, lines 8-18; lines 37-42); “automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered” (col.16, lines 55-62; col.17, lines 17-26; col.19, lines 42-47); “responsive to at least one action selected from the group consisting of a user input and an automatic system control, presenting an order menu on said display, said order menu comprising at least one replacement part order option” (col.4, lines 12-13, lines 23-26, lines 45-67; col.7,

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lines 18-23; col.8, lines 3-14; col.13, lines 58-64); and “responsive least one action selected from the group consisting a user input and an automatic system control, automatically communicating an order to a replacement part order center a replacement for said part” (col.4, lines 12-13, lines 23-26, lines 45-67; col.7, lines 18-23; col.8, lines 3-14; col.13, lines 58-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of the cited references, wherein the intelligent computer integrated maintenance system, provided therein (see Cornett’s fig.1, item 1) would incorporate the use of automatically generating a user notification when comparison of said parameter to said at least one replacement criterion indicates that a replacement part should be ordered, in the same conventional manner as disclosed by Crisp (col.16, lines 55-62; col.17, lines 17-26; col.19, lines 42-47). One having ordinary skill in the art would have found it motivated to generate a user notification indicated when a replacement part should be ordered because that provide Cornett’s system the enhanced capability of making appropriate orders as necessary

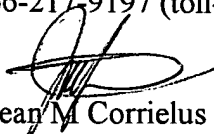
### *Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jean M Corrielus  
Primary Examiner  
Art Unit 2162

March 23, 2005